

applications in the chain for which the present application is entitled to benefit under 35 U.S.C. §120, include U.S. application Serial No. 07/679,317, filed April 2, 1991, now U.S. Patent No. 5,233,191, and U.S. application Serial No. 07/778,363, filed October 17, 1991, now U.S. Patent No. 5,274,434. Applicants note that the claimed subject matter of claims 1-11 of this application are considered to be supported at least by the disclosure of one of the prior applications of this application as represented by U.S. Patent No. 5,274,434, having a U.S. filing date of October 17, 1991. Since the cited patent to Tsuji et al has a U.S. filing date of December 2, 1992, which is subsequent to the U.S. filing date of October 17, 1991, to which the present application is entitled under 35 U.S.C. §120, applicants submit that Tsuji et al is not available as prior art in rejecting claims of this application under 35 U.S.C. §102 or 35 U.S.C. §103. As such, applicants submit that claims 1-11 should be considered allowable over Tsuji et al.

Furthermore, with respect to Tsuji et al, applicants submit that this patent, contrary to the Examiner's contentions, fails to disclose a semiconductor fabrication line formed of processing apparatuses and in which the substrate process is transferred to a detecting apparatus without removal of the substrate from the semiconductor fabrication line while continuing fabrication of the

semiconductor devices as recited in claims 1-11 of this application. Applicants submit that Tsuji et al does not disclose a semiconductor fabrication line with inspection being carried out in the manner defined, since although Fig. 8 of Tsuji et al discloses a semiconductor manufacturing system including the inspecting device, such does not represent a fabrication line with plural processing apparatuses, and likewise, Fig. 9 of Tsuji et al also does not disclose such features. Furthermore, the Examiner has noted that with respect to claims 1, 9 and 10, Tsuji et al discloses the claimed invention except for determining the particle generation condition and the amount of defects. The Examiner contends because Tsuji's apparatus inspects for defected particles and corrects the defected particles by using the cleaning device so the claim generating the particle condition would have been inherent. A skilled artisan would have been motivated to modify Tsuji's system to determine the amount of the defects so that it can calculate the time needed to clean. The modification would save time and costs. Tsuji's system uses a single processing system to detect the defect so that the claim memory would have been inherent. Applicants note that the Examiner makes similar contentions with respect to other claimed features. Applicants submit that even though Tsuji et al is not properly utilizable in rejecting claims of this application, the analysis utilized by the Examiner in

applying Tsuji et al to the claimed invention represents a hindsight reconstruction attempt utilizing the principle of "obvious to try" which is not the standard of 35 U.S.C. §103. Reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Thus, it is apparent that irrespective of the position by the Examiner, Tsuji et al does not disclose the claimed invention as set forth in claims 1-11 in the sense of 35 U.S.C. §103 and, as indicated above, all claims should be considered allowable at this time.

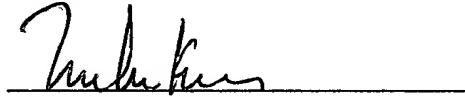
With respect to the newly added claims 12-25, applicants submit that such claims recite further features of the present

invention and are based upon the disclosures of the earlier filed applications for which this application is entitled to benefit under 35 U.S.C. §120, such that Tsuji et al is also not applicable thereto.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.30598CC3) and please credit any excess fees to such deposit account.

Respectfully submitted,



Melvin Kraus
Registration No. 22,466
ANTONELLI, TERRY, STOUT & KRAUS, LLP

MK/cee
(703) 312-6600



501.30598CC3
S.N. 09/805,188

VERSION WITH DRAWINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Page 1, please amend the paragraph beginning at line 5 as follows:

Cross-Reference to Related Applications

This application is a continuation application of U.S. application Serial No. 08/535,577, filed September 28, 1995, which is a continuation application of U.S. application Serial No. 08/046,720, filed April 16, 1993, now U.S. Patent No. 5,463,459, which is a continuation-in-part of U.S. application Serial No. [07/679,313] 07/679,317, filed April 2, 1991, now U.S. Patent No. 5,233,191 and U.S. application Serial No. 07/778,363, filed October 17, 1991, now U.S. Patent No. 5,274,434, U.S. application Serial No. 07/778,363 being a continuation-in-part application of U.S. application Serial No. 07/679,317.

RECEIVED
JAN 23 2002
TECHNOLOGY CENTER 2800